

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the foregoing amendments and following remarks. By this Amendment/Response, new claim 105 has been added. Applicant submits that support for the new claim may be found throughout the originally filed specification, drawings and claims, and that no new matter has been added by way of this Response. Claims 1-92 and 105 are currently pending.

Claim Rejections under 35 U.S.C. § 103

Claims 1-92 have been rejected under 35 USC § 103(a) as allegedly being unpatentable over Lee et al., U.S. Patent no. 6,535,883 (hereinafter, "Lee") in view of Nugent, "Addressing Form Field Validation with Regular Expressions and JavaScript 1.2" (hereinafter, "Nugent") and in further view of Brooke et al., U.S. Patent no. 6,748,569 (hereinafter, "Brooke"). Applicant respectfully traverses the Examiner's rejections and submits that a *prima facie* case of obviousness has not been established and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant submits that the rejections in the pending Office Action do not establish each of these requirements.

Applicant submits that, by over-generalizing the cited references, the rejections in the September 18, 2008 Office Action do not establish at least either of the first two elements of a *prima facie* case of obviousness. Independent claim 1 recites, *inter alia*,

A method, comprising:
...
retrieving customizable inheritable validation rules
appropriate for the retriever's input analysis capabilities from a
hereditary rules library stored in a memory device; and
...

Applicant submits that the cited references, taken alone or in combination, do not discuss or render obvious at least these claim elements recited in independent claim 1. The pending rejection alleges,

Lee further discloses retrieving customizable validation rules appropriate for a retriever's capabilities (i.e. col. 3 lines 19-40; col. 4 lines 27-41). Lee does not explicitly teach retrieving customizable inheritable validation rules appropriate for a retriever's input analysis capabilities from a hereditary rules library. Brooke teaches it was known in the pertinent art, at the time applicant's invention was made, to extend and reuse the validation rules (i.e. col. 13 lines 15-25). (September 18, 2008 Office Action, p. 3, ¶ 1).

Applicant respectfully traverses this argument and submits that none of the cited references discuss or render obvious at least "a hereditary rules library". Lee makes no mention of a library whatsoever. Validation rules are specified ad hoc via the graphical user interface. Brooke's system has nothing to do with validation rules, but rather is directed to "page display software languages for programmers on the world wide web" (Brooke, col. 1, lines 6-7). Regardless, the only mention of a library in Brooke is at col. 10, lines 48-49, wherein one XSP script may treat another script as a list of subroutines, having no interrelational hereditary structure, from which to draw. Applicant submits that an XSP script for page display is in no way analogous to "a hereditary rules library" as recited in independent claim 1.

Applicant further submits that the pending rejection has not shown or described how "retrieving customizable inheritable validation rules appropriate for the retriever's input analysis capabilities," as recited in independent claim 1, is allegedly discussed or rendered obvious by the applied references. Lee is directed to a user interface system for graphical generation of validation rules (see, e.g., Lee, Abstract). Not only does a user of Lee's system generate rules rather than "retrieving," but there is no discussion of a "retriever's input analysis capabilities" in Lee, so Lee's system is manifestly incapable of "retrieving customizable inheritable validation rules appropriate for the retriever's input analysis capabilities," as recited in independent claim 1.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" [§ 2143.03, emphasis added]. Applicant respectfully submits that, by over generalizing the references, the pending rejection has failed to consider "[a]ll words in [the] claim in judging the patentability of that claim against the prior art." Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicant respectfully requests clarification as to how and specifically where the Examiner believes the applied references discuss "a hereditary rules library" and "retrieving customizable inheritable validation rules appropriate for the retriever's input analysis capabilities," as recited in independent claim 1.

Furthermore, Applicant submits that the pending rejection has failed to properly set forth the differences in the claims over the applied references and to explain why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention

was made by proposing combinations of incompatible references that would change the principles of operation of those references, by failing to provide sufficient objective rationale for modifying the references, and by not providing a discussion of the level of ordinary skill in the art.

MPEP § 2143.01(VI) prescribes "[t]he proposed modification cannot change the principle of operation of a reference," and, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."

Applicant submits that the proposed combination of Lee and Brooke would change the principle of operation of both references and would not result in Applicant's claim. Lee is directed to a user interface system for graphically generating validation rules via tree-structured formats (see, Lee, Abstract and reference generally). In contrast, Brooke is directed to "page display software languages" comprising scripting languages to extend XML capabilities (see, e.g., Brooke, Abstract and col. 1, lines 6-9). Applicant submits that applying the "low level 'base' scripts" and "user scripts" in Brooke's XSP page display scripting system to the graphical user interface system of Lee would change its principle of operation. In fact, it is not clear how or why a "page display software language[]" would even be applied in Lee's graphical validation rule generation system. There is no way that Brooke's scripts for rearranging web page spatial layout could even be meaningfully interfaced to Lee's rule generation GUI, and it is incomprehensible how it would result in "retrieving customizable inheritable validation rules appropriate for the retriever's input analysis capabilities from a hereditary rules library stored in a memory device," as recited in independent claim 1; it cannot. Similarly, it is not clear how Lee's graphical validation rule generation system would or could be applied to Brooke's XML scripting

language, and it seems clear that any such application must necessarily change the principle of operation of Brooke's system. MPEP § 706 recites that, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Applicant submits that the pending rejection has failed to "clearly articulate" how the seemingly incompatible applied references could be combined to allegedly yield the claim elements without changing their principles of operation. Accordingly, Applicant submits that a *prima facie* showing of obviousness has not been made and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner disagree and maintain the rejection, Applicant respectfully requests clarification as to precisely how the Examiner believes the applied references could be modified to overcome their mutual incompatibility and allegedly yield the claim elements without altering the references' principles of operation.

Applicant submits that the Examiner has not provided sufficient objective rationale for modifying and/or combining the applied references. By way of example only, Applicant notes that the pending rejection alleges, "It would have been obvious for one having ordinary skill in the art to modify Lee's disclosed system to incorporate the teachings of Brooke. The modification would be obvious because one having ordinary skill in the art would be motivated to reuse validation logic with very little code by using inheritance as taught by Brooke." Applicant respectfully submits that the alleged rationales for the proposed modifications of the references are overly general, apply impermissible hindsight, and fail to articulate the rationale connecting the applied references to the proposed modifications. In the above example, it seems that the Examiner is essentially stating that it would have been obvious to modify Lee with the inheritance of Brooke because one of ordinary skill in the art would be

motivated to use inheritance. Applicant further traverses the notion that merely stating an alleged advantage (e.g., "to reuse validation logic with very little code") constitutes sufficient objective rationale for the proposed modifications of the applied references for, otherwise, the Examiner could deem any invention obvious simply because it had advantages over the prior art. MPEP §2141 (III) states, *inter alia*, "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious," and that, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide clarification of his reasons for alleging that the claims would have been obvious, including a "clear articulation of the reason(s)" that is based on evidence drawn from the references themselves.

Applicant also submits that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection refers to "one having ordinary skill in the art," (e.g., September 18, 2008 Office Action, p. 2, § 4) but has provided no indication or discussion of which art is described or the level of ordinary skill associated therewith. The rejection's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicant submits that impermissible hindsight has been applied in asserting obviousness of the various claim elements without

providing an indication of the level of ordinary skill. As such, Applicant respectfully requests that, if the Examiner maintains this rejection, the Examiner discuss the level of ordinary skill in the art at the time of the invention and clarify how the claimed subject matter would have been obvious to one possessing that level of skill.

Although of different scope than claim 1, Applicant submits that independent claims 7, 13, 19, 25, 30, 35, 40, 45, 51, 57, 63, 69, 75, 81, and 87 are patentable over Lee in view of Nugent and in further view of Brooke for at least similar reasons to those discussed above identifying deficiencies in the applied references with regard to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections.

Furthermore, Applicant submits that claims 2-6, 8-12, 14-18, 20-24, 26-29, 31-34, 36-39, 41-44, 46-50, 52-56, 58-62, 64-68, 70-74, 76-80, 82-86 and 88-92, which are directly or indirectly dependent from independent claims 7, 13, 19, 25, 30, 35, 40, 45, 51, 57, 63, 69, 75, 81 and 87, are also not discussed or rendered obvious by the applied references, taken alone or in combination, for at least similar reasons to those discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claim elements, there was/is no reason, rationale or motivation (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)) for such a combination of references, and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-92 and 105 all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed here or in previous amendments/responses, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-074US1. In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-074US1.

Respectfully Submitted,
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